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No. 00-1543

Supreme Court, U.S.
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In The

Supreme Court of the United States

FESTO CORP.,

Petitioner,

v.

SHOKETSU KINZOKU KOGYO KABUSHIKI CO., LTD., a/k/a SMC CORP., and SMC PNEUMATICS, INC.,

Respondents.

On Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF *AMICUS CURIAE* OF SEAN PATRICK SUITER IN SUPPORT OF NEITHER PARTY

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INTEREST OF *AMICUS CURIAE*[1]

This brief *amicus curiae* is submitted by Sean Patrick Suiter, pursuant to Rule 37 of the Rules of this Court. *Amicus Curiae* takes no position with respect to the holdings in the case under review by this Court, nor does he take a position with respect to the patent in question. Numerous briefs exploring the case precedent and issues are before this Court. *Amicus Curiae* does not wish to duplicate the work done by others. However, to establish a background of the issues to be resolved, *Amicus Curiae* requests the Court to consider the information contained herein.

Amicus Curiae is in position to provide the Court with this information. He is a patent attorney who handles many patent applications and prosecutions. *Amicus Curiae* respectfully submits this brief to provide the Court with possible historical and practical information to either affirm or reverse the Court of Appeals' decision.

JURISDICTIONAL STATEMENT

Amicus Curiae takes no position as to any jurisdictional statements contained in the Petitioner's or the Respondents' briefs.

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[1] The parties have consented to the filing of this brief.

Counsel for a party did not author this brief in whole or in part. No person or entity, other than the *Amicus Curiae*, its members, or its counsel made a monetary contribution to the preparation and submission of this brief.

STATEMENT OF FACTS

Amicus Curiae takes no position as to any statements of fact contained in the Petitioners' or the Respondents' briefs.

SUMMARY OF ARGUMENT

The lower court's decision is consistent with a growing favoritism of public notice over other competing interests said to achieve patent system policy rationales. While such favoritism may obtain certain beneficial results, a more judicially rigorous application of the principles of equity may be required to harmonize the interests of those parties seeking to benefit from the United States Patent System ("Patent System").

ARGUMENT

The function of the Patent System is to promote technology for public good. None of the various competing interests said to further the stated purpose of the Patent System need be considered superior. The overriding principle of a court applying an equitable doctrine should be to perform equity.

I. THE LOWER COURT'S DECISION SHOULD BE REVIEWED TO DETERMINE WHETHER IT WILL FURTHER THE PURPOSE OF THE PATENT SYSTEM.

The Court should consider the public-policy rationale of the Patent System in reviewing the lower court's decision. In such a review the Court should determine whether the lower court's holding best "promote[s] the progress of science and the useful arts."[2]

The learned court below[3] held, "an amendment that *narrows* the scope of a claim for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to *the amended claim element*." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 563-64 (Fed. Cir. 2000), *cert. granted*, 69 U.S.L.W. 3779 (U.S. June 18, 2001) (No. 00-1543) (*emphasis added*).[4]

This holding provides a mechanism for fixing the relationship between the doctrine of equivalents and prosecution history estoppel. The mechanism favors

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[2] U.S. CONST. art. I, § 8, cl. 8.

[3] The Federal Circuit is the sole arbiter of patent appeals from the district courts. 28 U.S.C. § 1295.

[4] Many commentators consider *Festo* to herald the end of the doctrine of equivalents. While the holding certainly reduces the scope of any amended claim—it does so only by removing equivalents for any claim *element* amended to overcome a statutory rejection. All other limitations (elements to the claimed combination) apparently retain a full range of equivalents.

notice and judicial economy over other competing interests.

II. COMPETING INTERESTS SHOULD BE BALANCED AGAINST EACH OTHER ONLY TO THE EXTENT EACH INTEREST FURTHERS THE FUNCTION OF THE PATENT SYSTEM.

Society abhors both monopolies[5] and forfeiture.[6] Thus, patents are only suffered to the extent necessary to prevent an inventor's forfeiture of his invention. Consequently, the Patent System must balance the interests of the public against the interests of inventors. The Patent System seeks to accomplish this goal by providing inventors with a limited right to exclude in exchange for public disclosure.

It should, at first be realized, that although the dissemination of knowledge, once known, is relatively free,[7]

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[5] See, for example, *Precision Instrument Mfg. Co. v. Automotive Maintenence Mach. Co.*, 324 U.S. 806, 816 (1945).

[6] PROFESSOR POMEROY, EQUITY JURISPRUDENCE § 363 (5th ed. 1941).

[7] "If nature has made any one thing less susceptible than all others of exclusive property, it is the action of the thinking power called an idea, which an individual may exclusively possess as long as he keeps it to himself; but the moment it is divulged, it forces itself into the possession of every one, and the receiver cannot dispossess himself of it. Its peculiar character, too, is that no one possesses the less, because every other possesses the whole of it. He who receives an idea from me, receives instructions himself without lessening mine; as he who lights his taper at mine, receives light without darkening me. That ideas should freely spread from one to another over

an invention's value should neither be predicated on the ease by which knowledge of an invention may be shared, nor the ease by which the benefits of an invention may be reproduced. The Patent System must allow an invention to be valued in light of the reciprocal public gain derived from the invention.[8] This goal may not be obtained solely through market forces.

Courts should prefer rules providing predictable results at a reasonable cost to litigants. However, courts do not want copyists to exploit inventors since inventor satisfaction ultimately determines the availability and cost of technology.

The Patent Office's mandate, then, is to determine what is patentable. Such a determination requires the ability to ascertain the scope of an invention[9] at a low cost to inventors and the public. Inventors expect to be rewarded in a fashion reasonably related to the level of value consumers (the public) place on their invention. An invention may be defined as the difference between what has been disclosed (taught) by the inventor which was previously unknown and which was already known to

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the globe, for the moral and mutual instruction of man, and improvement of his condition, seems to have been peculiarly and benevolently designed by nature." WRITINGS OF THOMAS JEFFERSON, 180-181, H.A. Washington Ed. (1854). President Jefferson was the first patent commissioner and a proponent of including patent rights in the Constitution.

[8] See, for example, A. Oddi, *Un-Unified Economic Theories of Patents*, 71 NOTRE DAME L. REV. 267, 277 (1996).

[9] THE INVENTION. See note 11 *supra*.

the public[10] (I = D – P, where *I* is the invention, *D* is the inventor's disclosure, and where *P* is the prior art).[11]

The Patent Office, in its *ex parte*[12] role or capacity, was not conceived or structured to fully balance the public-policy rationale behind the Patent System.[13]

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[10] Brethren in the patent bar will recognize this as a simplification. Nonetheless it is accurate in all but extreme cases (not present here) and will be instructive in resolving controversies of this type.

[11] Of course the INVENTION (*I*) must meet the requirements of Title 35 of the United States Code, Title 37 of the Code of Federal Regulations, and may need to conform with certain practices of the USPTO (see the *Forward* to the Manual of Patent Examining Procedure ["MPEP"], Rev. 1, Feb. 2000, the third sentence). The INVENTION may neither include, for example, matter dedicated to the public (35 U.S.C. § 102), nor may the prior art include non-analogous art (35 U.S.C. § 103). The understanding of the INVENTION may also change with newly discovered prior art, and/or later discovered uses or extensions unknown in the prior art; (whether such later discovered uses or extensions flow from the INVENTION, or to the contrary are independent of, or non-obvious over, the original teaching may be a question of law according to a well-reasoned principle of *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996)).

[12] See MPEP 713.06 "No *Inter Partes* Question Discussed *Ex Parte*."

[13] Potential infringement and potential further improvement derived from the added teaching of a patent may only be considered in the abstract during prosecution in the Patent Office (there being no case or controversy with another party). Probably, the USPTO cannot even effectively warn (even *pro se*) applicants that amending in response to a rejection under 35 U.S.C. § 112, ¶ 2, for example, rather than appeal to the Board of Patent Appeals and Interferences, will result in loss of equitable protection under the doctrine of equivalents (see for example, alleged omission of essential cooperative relationships, MPEP ¶ 7.34.14, pages 700-34, Rev. 1, Feb. 2000).

Courts in *inter partes* proceedings are confronted by a controversy of competing interests which they are structured to resolve. Issues that require a determination of whether an accused infringer is tortiously benefitting from the natural proximate benefits arising from an inventor's invention must be left to courts. Likewise, courts are better suited to determine whether an accused infringer has really added to the art by extending new benefits to consumers through non-obvious improvements to another's invention (such innovation should also be rewarded).[14]

Inventors also want notice allowing them to cost-effectively determine what areas of a particular art may be the most fruitful (state of the art). Cumulative or duplicative endeavors may lead to expensive controversies that consume an invention's value.

Additionally, the public benefits from the disclosure of the invention. Such disclosure provides knowledge constructive in further technological advancements—this

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[14] Everything is a combination of known elements. Even protons are combinations of quarks. See for example, R. Fenyman, SIX NOT-SO-EASY PIECES: EINSTEIN'S RELATIVITY, SYMMETRY, AND SPACE-TIME, Helix Books (1997). Note the following Federal Circuit statements, more cautious than the Nobel Laureate's: "Most, if not all, inventions are combinations and mostly of old elements." *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 U.S.P.Q. 8, 12 (Fed. Cir. 1983); and "[V]irtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983).

both advances individual technologies and increases technology choices.

Various competing interests seek balance in inquiries regarding a patent system, these include: fostering invention,[15] promoting public disclosure,[16] rewarding inventors for inventions,[17] public notice,[18] judicial economy,[19] and economy within a patent office.[20] A result harmonizing these interests should be favored by the Court.

The public notice function of a public policy rationale for a patent system is critical to obtaining several desirable goals. These goals range from the fundamental

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[15] *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989). This goal is emphasized in the Constitutional grant of power to Congress "[t]o promote the Progress of Science and useful arts by securing for limited times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.

[16] *Universal Oil Prods. Co. v. Globe Oil & Ref. Co.*, 322 U.S. 471, 484 (1944).

[17] See note 8 *supra*. Without protection, the inventor may want to hoard his ideas since disclosure might result in financial exploitation and copying by others.

[18] *Warner-Jenkinson Company, Inc., v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29 (1997).

[19] For an excellent chronology and analysis of pre-*Festo* doctrine of equivalence cases, see Mary S. Consalvi, et al., *Objective Indicia of Equivalence and Nonequivalence: an Update*, 573 PLI/Pat. 171(New York City, October 7-8, 1999). See also Joseph S. Cianfrani, *An Economic Analysis of the Doctrine of Equivalents*, 1 Va. J.L. & Tech. 1 (Spring 1997).

[20] Courts and the Patent Office sometimes have competing economies, see for example, *Green v. Rich Iron Co.*, 944 F.2d 852, 853 (Fed. Cir. 1991).

fairness required to assess liability against infringers, to the instructional framework disclosure provides for competitors to design around inventions. Thus, "the federal patent laws must determine not only what is protected, but also what is free for all to use." *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*[21] The metes and bounds of the patent should be clearly expressed to the public so they understand the limits of the patent claims. This allows competitors to compete with greater certainty so as to diminish the risk and cost associated with participating in a particular art. Notice is an important goal since the most efficient outcome in an economy is achieved through complete knowledge.[22]

Competing interests must be resolved in any controversy attempting to balance various parties' positions against the public policy rationale for the Patent System. For example, consumers (citizens) want to reward inventors for only what the inventor has invented. Consumers also desire the lower cost obtained through competition which also provides product and service enhancements.

Consumers' and inventors' interests compete in another significant way concerning the scope of a patent. Inventors want patents that extend to the natural[23]

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[21] 489 U.S. at 151 (1989).

[22] H. Demsetz, *Toward a Theory of Property Rights*, 57 AMER. ECON. REV. 347 (1967).

[23] See for example, J. Locke, *Second Treatise of Government*, ¶ 27 (1690). Also of interest are: J. Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287 (1988); and W. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533 (1993).

approximate benefits arising from their inventions. Consumers, on the other hand, want to limit this extension so as not to discourage others from making non-obvious combination improvements.

The sovereign, through the patent office and the courts, must first balance the competing interests of inventors and the public. A patent office seeks to provide the public with notice of what an invention is without unnecessarily increasing either the cost of technology to consumers or the cost of patenting to inventors. The Patent Office is, therefore, charged with assisting in fairly determining the scope of an invention in *ex parte* proceedings. The Patent Office may not be the best forum, in its capacity of establishing the scope of an invention (as the public's representative and advocate) to burden applicants and examiners with a rigid estoppel rule, particularly during what has largely been (pre-*Festo*) an intellectual pursuit of the scope of an invention. It seems probable, applicants and examiners, recognizing limitations in our ability to claim the metes and bounds of inventions,[24] may be more inclined to issue questionable

[24] Many have commented on the imperfect nature of language. "There is no complete language, no language which can express all our ideas. . . . all languages are, like us, imperfect." Voltaire, THE PHILOSOPHICAL DICTIONARY, (H.I. Woolfe, ed. & trans., Knopf) (1924). See also Justice Story's statement regarding copyright and patent cases as coming "nearer than any other class of cases belonging to forensic discussions, to what may be called the metaphysics of the law where the distinctions are, or at least may be, very subtile [sic] and refined, and, sometimes, almost evanescent." See *Folsom v. Marsh*, 9 F. Cas. 342, 344 (C.C.D. Mass. 1841).

patents, and applicants less willing to amend and more likely to appeal.[25]

The rule in *Festo* may further the public's interest in decreasing the cost of new inventions with increased competition due to more easily ascertainable patent scope (providing an enhanced ability to design around patents). Thus, the public will receive the natural inured benefit flowing from these new inventions. In addition, through the narrowed scope of claims the public may receive better notice of the exact limits of patents allowing the suggestion of other non-obvious inventions.

However, the rule in *Festo* may discourage inventors from inventing if the Patent System offers a perceived decreased protection for patents. Consumers may no longer receive the benefits of competition and new technology since inventors are no longer rewarded to the same perceived extent. This may result in less dissemination of knowledge to the public.[26]

The desire of inventors to obtain a reward for their inventions may be thwarted by the rule in *Festo*. An unscrupulous, would-be infringer may need only substitute an equivalent element recited in an amended claim in order to survive an allegation of infringement. Therefore, the inventor would not receive the anticipated reward for his invention even though the spirit of the

[25] Roberta J. Morris, *Open Letter to the Supreme Court Concerning Patent Law*, 83 J. PAT. & TRADEMARK OFF. SOC'Y 438, 441 (2001).

[26] Innovators being compelled to maintain their inventions as "trade secrets."

invention has not changed.[27] The public notice resulting from the rule in *Festo*, however, benefits the inventor. The rule provides the inventor with the ability to develop new inventions in response to consumer market demand with less concern about possible infringement. The rule provides notice to the inventor as to the limits of the amended patent claims without requiring a doctrine of equivalents analysis.

The inventor may also benefit from the rule in *Festo* by predictability in both the limits of patents and in litigation results. Under the *Festo* rule, inventors may not need a lengthy adjudication to determine claim equivalents and whether an accused infringer used equivalents (resulting in decreased expenses in enforcing a patent).

However the cost of patent prosecution may increase as a result of the rule in *Festo*. To avoid amendments, patent applicants will spend more time and money preparing claims and searching prior art. These increased costs may prevent small entities from pursuing patent protection, decreasing the amount of technology disseminated to the public.

The rule in *Festo* may be argued as improving judicial economy.[28] The Federal Circuit based its decision in *Festo* in part on the "unworkab[ility]" of the prior rule."[29] With

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[27] Limits in the English language and its usage may prevent claims from fully comprehending the scope of an invention. See also note 23 *supra*.

[28] Bruce J. Rose, et al., *Was Festo Really Necessary*, 83 J. Pat. & Trademark Office Soc'y 111, 135 (Feb. 2001).

[29] 234 F.3d 558, 575.

better public notice as to the scope of patents, it would seem judicial economy would be enhanced. However, making decisions in an attempt to ameliorate the judiciary and Patent Office burden may only shift the burden in the Patent System. It is crucial other important policies behind the Patent System not be overcome by attempts to cure the practical problems within judicial and Patent Office "economies."[30]

Additionally, a bright line rule may only shift the burden to the government.[31] Applicants are already arguing and appealing examiner requests for amendments to avoid (automatic) prosecution history estoppel. The decision may greatly increase the time an examiner must spend on each patent application.[32] Due to the already large workload, increasing it would benefit neither the government nor the public.

While increased certainty and judicial economy are important goals, the result may not be economical. The rule may only shift the heavy burden placed on the judicial system to the Patent Office and prosecution—ultimately creating more cases for already crowded dockets.

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[30] In that these bodies seek to achieve the correct result with the greatest efficiency.

[31] Increased taxes and/or user fees may result.

[32] 293,244 patent applications were submitted in 2000 to be examined by an average of 3000 patent examiners. (Nicholas P. Godici, *Performance and Accountability Report: Fiscal Year 2000* (visited July 6, 2001) *http://www.uspto.gov/web/offices/com/annual/2000/00patents.pdf*. Patent Office Professional Association Website, April/May 2001 Newsletter, (visited July 6, 2001) *http://www.popa.org/newsletters/aprmay01.shtml*.

In any case, the *Festo* rule may thwart the interest of both inventors and consumers and impede courts when a result dictated by equity may be unavailable as a result of the rigidity of the rule. Principles already exist for resolving the relative interests of the parties according to the public policy rationale (*Markman* [claim interpretation is a matter of law], *Warner-Jenkinson* [rebuttable presumption], *Graver Tank* [reverse doctrine of equivalents],[33] *Wilson Sporting Goods* [re-capture unavailable]; and *Penwalt* [all elements rule]).

III. THE COURT OF APPEALS DECISION MAY BE APPLIED SO AS TO RETAIN THE EQUITABLE UNDERPINNINGS OF THE DOCTRINE.

The judiciary created the doctrine of equivalents in equity in order to carry out the policies not satisfied by the rule of law.[34] This doctrine "regards as done which ought to be done"[35] by protecting the equivalents as well as literal claims.

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[33] 339 U.S. 605 (1950). *Amicus Curiae* confesses an admiration for this decision. *Amicus* is most impressed by the principles found in *dicta* regarding the so called "reverse doctrine of equivalents." This principle seems pregnant with a solution for this type of controversy. This admiration is retained even with the criticism reported in M. J. Adelman, et al., CASES AND MATERIALS ON PATENT LAW, 897-900, West Group (1998). Note also the historicism found in D.S. Chisum, et al., PRINCIPLES OF PATENT LAW, 900-910, Foundation Press (2001).

[34] See in particular, Vol. 1, § 258, William C. Robinson, THE LAW OF PATENTS FOR USEFUL INVENTIONS, Vol. 1-3 (1890). This is perhaps the most scholarly work in the patent law.

[35] PROFESSOR POMEROY, EQUITY JURISPRUDENCE § 363, (5th ed. 1941).

A. HISTORY OF THE DOCTRINE.

The doctrine of equivalents has evolved over time. In one of the first applications of the doctrine, the court found infringement and used a "substantially like" test when comparing the invention to the accused device as a whole.[36] The court stressed the "[m]ere colorable alterations of a machine [we]re not sufficient . . . [to avoid infringement]."

The Patent Act of 1836 changed the patent process, formally requiring claims and an examination.[37] Under the 1836 Act, this Court established the doctrine of equivalents.[38] Despite the fact the accused device did not literally infringe, this Court found infringement under "the doctrine of equivalents" because the claim language simply referred to a single embodiment as an example of what the patentee intended to claim. In 1880, this Court further defined the protection the doctrine of equivalents provided patentees.[39] The Court "conceded the patentee is protected against equivalents for any part of his invention."[40] However, the Court also used prosecution history estoppel to prevent the patentee from arguing an interpretation of the claim denied during prosecution.

The landmark decision in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*[41] proposed the tripartite test used

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[36] *Odiorne v. Winkley*, 18 F. Cas. 581, 582 (C.C.D. Mass. 1814).

[37] Patent Act of 1836, ch. 357, 5 Stat. 117, 119 (1836).

[38] *Winans v. Denmead*, 56 U.S. 330 (1853).

[39] *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222 (1880).

[40] *Id.* at 230.

[41] 339 U.S. 605 (1950).

prior to the lower court's decision in *Festo*. This Court held: "[w]hat constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case."[42] The court reiterated the test to be whether an accused "device"[43] performs substantially the same function in substantially the same way to obtain the same result.

The Patent Act of 1952 required an applicant to "definitely and particularly point out what the applicant claims as his invention." 35 U.S.C. § 112. In addition, the Act allowed claims to be written in mean-plus-function language.[44]

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[42] This Court had held here that a finding of equivalence was a finding of fact.

[43] "Device" is used here and elsewhere to include any statutory subject matter. "[A]ny new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. . . . " 35 U.S.C. § 101.

[44] See *McGinley v. Franklin Sports, Inc.*, ___ F.3d ___, 2001 WL 939088 (Fed. Cir. 2001). In *McGinley* the Federal Circuit broadened the range of equivalents available under 35 U.S.C. § 112, ¶ 6 where means-plus-function claiming is utilized. The new range apparently includes all equivalents—including those equivalents implied in the patent specification. Thus, the Federal Circuit may be working to structure its decisions, relating to the "doctrine of equivalents" and "equivalents" under means-plus-function claiming, directly to 35 U.S.C. § 112. For example, 35 U.S.C. § 112, ¶ 2 requires "one or more claims particularly pointing out and distinctly claiming the subject matter the applicant regards as his invention." Conversely, 35 U.S.C. § 112, ¶ 6 provides: "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification *and equivalents thereof.*" (Emphasis added). Thus, under these two cases (*Festo* and *McGinley*) a range of equivalents is available to applicants utilizing means-plus-function claiming when they are not estopped from asserting a particular claim interpretation.

In *Hughes Aircraft Co. v. United States,*[45] for the first time, the court addressed the range of equivalents available when prosecution history estoppel applied. The Federal Court applied a flexible bar, stating that prosecution history estoppel may have a limiting effect on the range of equivalents available. The court also concluded that the doctrine of prosecution history estoppel precludes a patent owner from obtaining a claim construction which resurrects subject matter surrendered during prosecution.

Pennwalt Corp. v. Durand Wayland, Inc.[46] dramatically changed the test for the doctrine of equivalents. The test articulated in *Graver* was an element-by-element analysis of the claims. Here the Federal Circuit adopted the so-called all-elements rule finding the accused device did not perform a function of the patent.[47]

Corning Glass Works v. Sumitomo Electric U.S.A., Inc.[48] held an accused device must contain every limitation (element) of the patent before the doctrine of equivalents would apply.[49]

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[45] 717 F.2d 1351 (Fed. Cir. 1983).

[46] 833 F.2d 931 (Fed. Cir. 1987).

[47] Continuously locating the position of fruit.

[48] 868 F.2d 1251, 1258-59 (Fed. Cir. 1989).

[49] This approach was derived by the late Judge Nies through an analysis of this Court's precedent. This Court adopted the language of Judge Nies in *Warner-Jenkinson*.

The doctrine of equivalents was limited further by *Wilson Sporting Goods Co. v. David Geoffrey & Associates*,[50] which held equivalent elements within a claim could not produce a teaching encompassing an invention in the prior art. If an equivalent would not have overcome the prior art during prosecution, the doctrine of equivalents could not be utilized in litigation to re-capture the prior art.

In 1991, *London v. Carson Pirie Scott & Co.*[51] illustrated the Federal Circuit's concern that the doctrine of equivalents might be utilized to undermine the notice function of patent claims (in *dicta*). The Federal Circuit stated:

> [a]pplication of the doctrine of equivalents is the exception, however, not the rule, for if the public comes to believe (or fear) that the language of patent claims can never be relied on, and that the doctrine of equivalents is simply the second prong of every infringement charge, regularly available to extend protection beyond the scope of the claims, then claims will cease to serve their intended purpose. Competitors will never know whether their actions infringe a granted patent.

The court held the patent was not infringed because the case is one in which "the claims mean what they say." The claims may not extend to cover an accused device which does not copy the claim limitations (or elements).

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[50] 904 F.2d 677 (Fed. Cir. 1990).

[51] 946 F.2d 1534, 1538 (Fed. Cir. 1991).

Warner-Jenkinson Co. v. Hilton Davis Chem. Co.,[52] established a new rule for amendments where no reason is given for the claim amendment. The basic test remained the same, an element-by-element analysis. However, the rule established a rebuttable presumption that prosecution history estoppel bars equivalents when no reason was given for the amendment. This Court held a presumption of estoppel is created which a patentee may rebut by showing a claim was amended for reasons other than for patentability purposes:

> The presumption we have described, one subject to rebuttal if an appropriate reason for a required amendment is established, gives proper deference to the role of claims in defining an invention and providing public notice, and to the primacy of the PTO in ensuring that the claims allowed cover the only subject matter that is properly patentable. Applied in this fashion, prosecution history estoppel places reasonable limits on the doctrine of equivalents, and further insulates the doctrine from any feared conflict with the Patent Act.

B. PURPOSE OF THE DOCTRINE.

Finding that an equivalent actually embodies the same invention, the doctrine prevents copyists from making minor changes to a patent, within the spirit of an invention. This Court stated, "[a] limitation to copying every literal detail of an invention would leave room for —indeed encourage—the unscrupulous copyist to make

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[52] 520 U.S. 17, 33-34 (1997).

unimportant and insubstantial changes and substitutions in the patent which, though adding nothing would be enough to take the copied matter outside the claim, and hence outside the reach of law."[53] Thus, the ability to merely make insubstantial changes, and not infringe, is contrary to the equitable basis for the doctrine of equivalents.[54]

Prior to the lower court's decision in *Festo*, the judicial system applied a tripartite test to determine if an accused device infringed under the doctrine of equivalents: "[d]oes it perform substantially the same function in substantially the same way to obtain substantially the same result."[55] However, recently the Court has expressed concern about the doctrine, stating, "there can be no denying that the doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement."[56]

The lower court's holding may still maintain certain equitable characteristics based on reasons or maxims for "doing equity." Two maxims of equity support an argument for a complete bar in equity: "he who comes into

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[53] *Graver Tank v. Linde Air Products Co.* 339 U.S. 605, 606 (1950).

[54] Perhaps more clearly "outside the reach of the patent statutes and the equitable principles of the doctrine of equivalents."

[55] *Graver Tank*, 339 U.S. at 608 (citing, *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929)).

[56] *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29 (1997).

equity must come with clean hands, and he who seeks equity must do equity."[57] The Supreme Court of Kansas held in *Green v. Higgans*[58] "[t]he clean hands doctrine in substance provides that no person can obtain affirmative relief in equity with respect to a transaction in which he has himself, been guilty of inequitable conduct."

The parties involved in a patent application may be guilty of coming to equity with unclean hands. Claiming an invention such that an amendment of the claims is required during prosecution may be argued as making the applicant's hands unclean. However, claim rejections may be inappropriate and amendments may be made which are not necessarily the result of an attempted fraud by the applicant—nor indicating a change in position by the applicant requiring estoppel. For example, an applicant may not be aware of certain art prior to prosecution. Likewise, the Patent Office may obtain an improved understanding of the scope of an invention through an amendment (not necessarily limiting) made during prosecution. In neither case would the application of equity be offended nor would estoppel fairly result.

On the other hand, the lower court's rule may work a complete rejection of the equitable basis for the doctrine of equivalents. This Court has stated, "[t]he essence of the doctrine [of equivalents] is that one may not practice a fraud on a patent."[59] Merely by way of an amendment,

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[57] PROFESSOR POMEROY, EQUITY JURISPRUDENCE § 363 (5th ed. 1941).

[58] 217 Kan. 217 at 217 (1975).

[59] *Graver Tank*, 339 U.S. at 606 (addition for clarity).

the lower court's rule may result in finding non-infringement for otherwise infringing technology. Worse still, a result might be obtained where the accused infringer had constructive notice of the scope of the claimed invention. The fact an inventor has amended claims does not alter whether an accused infringer is practicing an inventor's "invention."[60] Additionally, both actual and constructive notice of the scope of an invention may exist under the law.[61] While actual notice of an invention's scope is implied through the claims,[62] constructive notice of an invention's scope may be ascertained as a matter of law.[63] At bottom, the doctrine of equivalents recognizes an accused infringer may technically avoid infringement of a patent claim while still "infringing" the INVENTION.[64]

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[60] "Well! I've often seen a cat without a grin," thought Alice; "but a grin without a cat! It's the most curious thing I ever saw in all my life!" Lewis Carroll, *Alice in Wonderland and Through the Looking Glass*, Signet Classics (Reissue 2000). "[C]at" = invention; and "grin" = patent.

[61] Notice may be implied. See for example, note 63 *infra*.

[62] 35 U.S.C. § 287(a).

[63] Would a reasonable competitor having ordinary skill in the art understand the scope of the INVENTION disclosed by the patentee?

[64] See *C. Van der Lely N.V. v. Bamfords Ltd.*, [1963] RPC 61 (H.L. 1962), wherein the British House of Lords found:

> Copying an invention by taking its "pith and marrow" without textual infringement of the patent is an old and familiar abuse which the law has never been powerless to prevent. It may be that in doing so there is some illogicality, but our law has always preferred good sense to strict logic. The illogicality arises in this way. On the one hand the patentee is tied strictly to the invention which he claims and the

In addition to allowing a potential fraud on patents, under the lower court's rule, an inventor might be forced to forfeit certain rights to their invention. "Equity abhors forfeiture."[65] Under the lower court's rule, regardless of the reason for a claim amendment (so long as the basis for the rejection was statutory), the inventor may forfeit the equivalents to which he "might" otherwise be entitled. It may be argued a patent's value should flow from its disclosure and the benefit directly obtained by the public.

> mode of effecting an improvement which he says is his invention. Logically, it would seem to follow that if another person is ingenious enough to effect that improvement by a slightly different method he will not infringe. But it has long been recognized that there "may be an essence or substance of the invention underlying the mere accident of form; and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination."

(Per James, L.J., in *Clark v. Adie* (1873) L.R. 10 Ch. 667.) As cited in M. J. Adelman, et al., CASES AND MATERIALS ON PATENT LAW, 890, West Group (1998). Perhaps such an inquiry should be a question of law or a mixed question of law and fact.

[65] PROFESSOR POMEROY, EQUITY JURISPRUDENCE § 363, (5th ed. 1941).

IV. IF NOT PROTECTED BY "WHOLESOME REALISM" OF REVERSE EQUIVALENTS, YOU INFRINGE?

Or is an analysis under 35 U.S.C. § 103 really different from a determination under the doctrine of equivalents.

Controversies of this type are difficult. Benjamin Franklin, one of our earliest and most prolific inventors, once wrote:

> There are everywhere a number of people, who being totally destitute of any inventive faculty themselves, do not readily conceive that others may possess it; they think of inventions as miracles; there might be such formerly, but they are ceased. With these, every one who offers a new invention is deemed a pretender. . . . They are confirmed, too, in these sentiments, by frequent instances of pretensions to intervention, which vanity is daily producing. That vanity, too, though an incitement to invention, is, at the same time, the pest of inventors. Jealousy and envy deny the merit of the novelty of your invention; but vanity, when the novelty and merit are established, claims it for its own. The smaller your invention is, the more mortification you receive in having the credit of it disputed with you by a rival, whom the jealousy and envy of others are ready to support against you, at least so far as to make the point doubtful. It is not in itself of importance enough for dispute; no one would think your proofs and reasons worth their attention; and yet, if you do not dispute the point, and demonstrate your right, you not only lose the credit of being in that instance *ingenious*, but you suffer the disgrace of not being *ingenious*; not only of being a plagiary, but of being plagiary for trifles. Had the invention been greater, it would have disgraced you less; for men have not so contemptible an idea of him that robs for gold on the highway, as of him that can pick pockets for half-pence or farthings. . . . One would not, therefore, of all faculties or qualities of mind, wish, for friend or a child, that he should have that of invention.[66]

The judiciary has a broad range of tools available to resolve conflicts such as these. None of which seems a more useful starting point than the reverse doctrine. In *Graver Tank* this court stated:

> The *wholesome realism* of this doctrine [of equivalents] is not always applied in favor of a patentee but is sometimes used against him. Thus, where a device is so far changed in principle from a patented article that it performs the same or similar function in a substantially different way, but nevertheless falls within the literal words of the claim, the doctrine of equivalents may be used to restrict the claim and defeat the patentee's action for infringement.[67] (Emphasis added).

CONCLUSION

The Federal Circuit weighed considerations in a fashion designed to balance the needs of the Patent System. It

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[66] Letter to John Lining, March 18, 1755. *http://www.bibliomania.com/2/9/77/124/21483/1.html*. Visited on August 25, 2001.

[67] 339 U.S. at 609.

may be argued since both the public and inventors are favored by considerations of cost and notice these factors should be superior.[68] However, such weighing may not always provide an equitable result. Perhaps the need to achieve consistent correct results prevents the use of bright line rules in controversies such as these.

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[68] Kindly note *Amicus Curiae*'s attached figure on page 27.